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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,925	02/05/2007	Hugh Fisher	28125-4	1156

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BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP
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EXAMINER

GITLIN, MATTHEW J

ART UNIT	PAPER NUMBER
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3635

NOTIFICATION DATE	DELIVERY MODE
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12/22/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@beneschlaw.com

Office Action Summary	Application No. 10/566,925	Applicant(s) FISHER, HUGH	
	Examiner Matthew J. Gitlin	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 11-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/01/2006, 12/18/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The examiner acknowledges the election, without traverse, of **Species I, Figures 1-7**, in the response filed 10/15/2009. Applicant has attempted to amend independent **Claim 11** to read upon elected Species I. After further consideration, Claim 11 and its dependants read upon a non- elected invention and are hereby withdrawn. Please see below.

Election/Restrictions

2. **Claims 11-37** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected **Species**, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on **10/15/2009**.

3. ***Regarding Claims 11-28***; After further consideration these claims, as amended, are drawn to Species IV. There is no connecting member disclosed in elected Species I, Figures 1-7. Per the claims, Figures 1-7 show the first and second attachment means, being tabs 34 and flange 24, directly and integrally connected to the panels 20, and having no connecting member (**Species IV, Elements 102/104**) there between. There is no way that one could construe a connecting member disclosed in the elected Species I, Figures 1-7. These claims stand withdrawn.

4. **In regards to the newest Claim listing as of 10/15/2009, the status identifiers for Non Elect Claims are not properly identified as “Withdrawn” instead are identified as ‘Previously Presented.’ Please correct this error on the next Claim listing.**

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “**strengthening formation**” of **Claim 5** and the “**reinforcing means**” of **Claim 6** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. **Claim 6** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. **Claim 6** is indefinite because the aperture is claimed as "a third aperture" when not every panel is claimed to have a first and second aperture, this aperture can not be a third aperture of one or more panels.

9. Also, applicant asserts that the claim element "**reinforcing means**" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, it is unclear whether the claim element is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph, because **the corresponding structure is not sufficiently disclosed in the written description of the specification**. If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to:

(a) Amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines: the phrase "means for" or "step for" must be modified by functional language and the phrase must **not** be modified by sufficient structure, material, or acts for performing the claimed function; or

(b) Show that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. For more information, see MPEP § 2181.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

11. A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 1-7 and 10** are rejected under 35 U.S.C. 102(b) as being anticipated by W. E. Crowder (US 3,368,316).

13. **Claim 1**; Crowder discloses a blank (Fig. 4) for forming a building element (Fig. 5), the blank comprising: an elongate body portion (Combination of adjacent panels 52 in Fig. 4) having first (Left end, Fig. 4) and second ends (Right end, Fig. 4) and a plurality of transverse fold lines (56) which divide the body portion into a plurality of panels (52), the panels each having first (**Left edges**) and second (**Right edges**) longitudinal edges; one or more first tab members (**62**) extending from the first end of the body portion; and one or more first apertures (**64**) adjacent the second end of the body portion; wherein each of said plurality of panels has at least one second tab (**66**) extending from said first longitudinal edge and a side flange portion (**74 and 76**) adjacent said second longitudinal edge, and wherein each side flange portion is provided with at least one second aperture (**78**).

14. **Claim 2**; Crowder discloses wherein each side flange portion is divided from its respective panel by a longitudinally extending fold line (**58**) which extends along the length of the body portion (**Fig. 4**), and wherein the side flange portions are adapted to be folded substantially perpendicular to their respective panels (**Fig. 5**).

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15. **Claim 3;** Crowder discloses wherein the body portion has an end flange portion (**60**) adjacent the second end thereof, the at least one first aperture being formed in the end flange portion (**Fig. 4**).

16. **Claim 4;** Crowder discloses wherein the end flange portion is divided from the body portion by one of the plurality of transverse fold lines (**56, Fig. 4**), and wherein the end flange portion is adapted to be folded substantially perpendicular to the body portion (**Not shown in Fig. 5, but capable of being folded any angle**).

17. **Claim 5;** Crowder discloses wherein one or more of the panels includes a strengthening formation (**66**) thereon.

18. **Claim 6, as best understood by the examiner;** Crowder discloses wherein one or more of the panels is provided with a third aperture (**Perforations of 56**).

19. **Claims 7 and 10;** Crowder discloses wherein the building element is a building block (**Fig. 5**).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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21. **Claim 8-9** rejected under 35 U.S.C. 103(a) as being unpatentable over W. E. Crowder (US 3,368,316).

22. **Claims 8-9;** Crowder does not expressly disclose wherein the blank is formed from sheet metal or formed from sheet plastics.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to try and provide the blank of Crowder with the blank being formed of sheet metal or sheet plastics, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (**In re Leshin, 125 USPQ 416**) and for the inherent material properties such as being inexpensive, easy to manufacture and being lightweight.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Gitlin whose telephone number is (571)270-5525.

The examiner can normally be reached on Monday - Friday (7:30am-5:00pm EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. G./

Examiner, Art Unit 3635

/Robert J Canfield/

for R. Chilcot, SPE of Art Unit 3635